

Election/Restrictions

Claims 1-7, 9-11, 13, 14, 17-23 and 29 are pending in the application and are subject to restriction and/or election requirement.

According to the Restriction Requirement, election/restriction to one of the following groups is required:

- I. Claims 1-3, drawn to an additive.
- II. Claims 4-7, 9-11, and 13-14, drawn to a coating composition.
- III. Claim 17, drawn to a method of making a coating composition.
- IV. Claims 18-22, drawn to a process of coating.
- V. Claim 23, drawn to a coated article.
- VI. Claim 29, drawn to a method of controlling the characteristics of a coating composition.

Remarks

Applicants hereby elect Group II, Claims 4-7, 9-11, and 13-14, drawn to a coating composition, with traverse.

The present application claims priority to a PCT application, and therefore PCT Unity of Invention Rules apply.

In order to support a finding of lack of Unity of Invention in a National Stage application filed under the PCT, the Patent Office must provide an explanation as to why the proposed groups lack unity with each other (i.e., why there is no single general inventive concept). This explanation must specifically describe the unique special technical feature in each group that distinguishes the groups from each other. MPEP 1893.03(d).

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. In the present case, the technical relationship among the claimed inventions is the technical feature relating to the rheological additive comprising illite clay, smectic clay and an attapulgite in

the context of coating materials and their uses. It is therefore respectfully submitted that the present claims are all linked by a single general inventive concept.

The Office Action states that the groups do not relate to a single inventive concept under the PCT rules, because "Claim 1 is obvious over either US Patent No. 4,968,445 or US Patent No. 5,925,182." The Office Action fails to provide reasoning as to why these references make rheological additive of claim 1 obvious, and do not identify relevant portions of the disclosures of these references. It is noted that US Patent No. 4,968,445 does not even mention illite clay and only mentions "colloid forming clays of smectite and/or attapulgite types" in the most general sense, without suggesting the combination as required in the present claim 1. Similarly, US Patent No. 5,925,182 only lists clays in a laundry list of possible clays for use in drilling compositions used in oil field applications, and would not render obvious a rheological additive for use in coating compositions.

It is respectfully submitted that the cited US patents do not alter the fact that the present claims involves at least one common or corresponding special technical feature. Examination of the present claims on this basis is respectfully requested.

Additionally, it is respectfully submitted that under the rules for restriction in the present case, in the minimum claims to a product, the method of making the product and the use of the product must be examined together. Thus, the present coating composition, the method of making the composition and the method of use (Groups II-IV), must be examined together.

The outstanding Office Action also sets forth a requirement for an Election of Species in this case. Applicants hereby elect the species of the Working Example 2.

It is respectfully submitted that all species should be examined together due to the commonalities of chemical constitution among the species.

It is respectfully submitted that, in view of the substantial commonality of the subject matter of all of the claims, the search for the subject matter of one of these groups will necessitate a search of the subject matter of the other groups. No substantial burden is therefore seen in consideration of these groups in a single application. Further, examination of the non-elected claims with the elected group provides efficiency in early

determination of the full scope of patent protection to be afforded in this technology, which is of great benefit to the public.

Conclusion

In view of the above election and remarks, it is respectfully submitted that the foregoing is fully responsive to the outstanding Restriction Requirement. Examination of all claims together, and early favorable consideration and passage of the above application to issue is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any issues in the application, the Examiner is invited to contact said attorney at (651) 275-9811.

Respectfully Submitted,

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By:



Dale A. Bjorkman, Reg. No. 33,084

Customer No. 33072

Phone: 651-275-9811

Facsimile: 651-351-2954